REMARKS

Presently, Claims 49 and 51 are canceled without prejudice or disclaimer. Claim 50 is amended to include the features of canceled Claim 51. Reconsideration and allowance of Claims 1, 4-6, 22-26, and 39-48, 50, 52, and 53 are respectfully requested.

35 U.S.C. §102(b)

Claims 1, 4-6, 22-26, 45-48, and 50-53 were rejected under 35 U.S.C. §102(b) as being anticipated by Harari, et al. (U.S. Patent No. 5,887,145; hereafter "Harari"). The Applicant respectfully traverses this rejection, and requests that the rejection be reconsidered and withdrawn.

Harari relates to a personal computer ("PC") card having a personal computer memory card interface association ("PCMCIA") form-factor PC mother card portion (col. 6, lines 63-67), which can be mated with an EEPROM memory chip daughter card (col. 7, lines 4-6 and 31-32).

With regard to Claims 1, 22, and 50, the rejection states that Harari teaches a PCMCIA form factor device 10 comprising an interface 14 to communicate with a storage card 20, and that the card assembly 100 can be connected to a host machine/system.

On the other hand, **Claim 1** recites an assembly comprising "a device physically sized in a form factor of a PCMCIA card, the device having an interface to communicate with a storage card and <u>a flash memory</u> to store user data" (emphasis added). The claimed assembly further comprises "a removable <u>smart card</u> associated with a user that alternately enables access to the user data on

the memory when interfaced with the device interface and disables access to the user data when removed from the device" (emphasis added). These features of Claim 1 are not anticipated by Harari.

In particular, Harari does not teach <u>the interface to communicate with a storage card and a flash memory</u> to store user data, as recited in Claim 1, nor does the rejection advance an argument to that effect. Instead, the Applicant submits that Harari teaches away from Claim 1. Specifically, although the mother card 10 (Harari, Fig. 1) is a PCMCIA form-factor PC card having an interface to communicate with storage card 20, the mother card 10 does not have a flash memory to store user data. Harari acknowledges, "The mother card 10 contains a memory controller 40 <u>but does not contain any substantial amount of flash EEPROM mass storage</u>," (col. 7, lines 37-39; emphasis added). Rather, it is daughter card 20 that "contains essentially flash EEPROM memory chip(s) 30," (col. 7, lines 31-32). Such description is contrary to the recitation of Claim 1.

Claim 22 recites a computer system comprising "a computer having a PCMCIA device reader," and "a smart card secured memory physically sized in a form factor of a PCMCIA card to compatibly interface with the PCMCIA device reader in the computer, the smart card secured memory assembly having data memory to store user data and a removable smart card that alternately enables access to the user data when present and disables access to the user data when removed." Applicants submit that, for reasons similar to those discussed above regarding independent Claim 1, Harari fails to anticipate Claim 22 and corresponding dependent Claims 23-26.

Claim 50 is presently amended to recite the removable means as including a flash memory and the data files stored therein including a user profile to configure a computer. Therefore, for reasons similar to those discussed above regarding independent Claims 1 and, Harari fails to anticipate Claim 50.

MPEP §2131 states that, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference," *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is respectfully submitted that Harari does not meet the standard of *Verdegaal Bros.* with regard to independent Claims 1, 22, and 50.

With regard to **Claims 23 and 48**, the rejection refers to col. 7, lines 24+ of Harari. The EEPROM memory chips on the daughter card 20 are not anticipatory of the smart card secured memory assembly having data memory to store user data (see Claim 22, from which Claim 23 depends), wherein the data memory comprises a flash memory, as recited in Claim 23. Similarly, the EEPROM memory chips on the daughter card 20 do not teach or even suggest the computer-readable medium of Claim 45, which is further recited as being portable flash memory in dependent Claim 48 depends. The rejection does not include an assertion to that effect.

Claims 4 and 5 depend from Claim 1, and are therefore distinguishable over Harari for at least the reasons set forth above regarding Claim 1. It is noted that the rejection does not specifically assert that Harari teaches the device storing a user's profile that can be used to configure a processor (Claim 4 and also **Claim 51**) or the smart card storing a passcode and access to the user data in the flash

memory being enabled upon authentication of a user-supplied passcode to the passcode stored on the smart card (Claim 5).

Similarly, **Claim 24** depends from Claim 22, and is therefore distinguishable over Harari for the reasons set forth above regarding Claim 22. The rejection does not specifically assert that Harari teaches the smart card storing a passcode or being configured to authenticate a user-supplied passcode entered into the computer as a condition for enabling access to the data, as recited in Claim 24.

Claim 6 depends from Claim 1, and is therefore distinguishable over Harari for at least the reasons set forth above regarding Claim 1. **Claims 25 and 26** depend from Claim 22, and are therefore distinguishable over Harari for at least the reasons set forth above regarding Claim 22. It is noted that the rejection does not address the specific features recited in Claims 6, 25, and 26.

Furthermore, the rejection does not address the specific features recited in **Claims 45-47, 52 and 53**. Therefore, it is respectfully submitted that the general description of an assignable code and secret key in Harari fail to anticipate the rejected claims.

It is respectfully submitted that, for at least the reasons set forth above, the proposed reference fails to teach all of the features presently claimed, and thus the rejection under 35 U.S.C. §102(b) should be withdrawn.

35 U.S.C. §102(e)

Claim 49 was rejected under 35 U.S.C. §102(e) as being anticipated by Ban, et al. (U.S. Patent No. 6,148,354; hereafter "Ban"). This rejection is

rendered moot by the cancellation of Claim 49. Therefore, the Applicant requests that this rejection be withdrawn.

35 U.S.C. §103(a)

Claims 39-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Harari in view of Ban. The Applicant respectfully traverses this rejection, and requests that the rejection be reconsidered and withdrawn.

In particular, by the attached Rule 131 Declaration, the Applicant has established invention of the subject matter of the present invention, including the presently rejected claims, prior to the April 5, 1999 filing date of Ban. Thus, it is respectfully submitted that Ban is not prior art in view of the present application, and the Applicant requests that this rejection be withdrawn.

CONCLUSION

All rejections having been addressed, it is respectfully submitted that all of Claims 1, 4-6, 22-26, and 39-48, 50, 52, and 53 are in condition for allowance. Early and forthright issuance of a Notice to that effect is earnestly solicited. If any issues remain that prevent issuance of this application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully submitted,

Dated: July 15, 2004   By: _____

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